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BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Decker Manufacturing Corporation

Serial No. 75/500,807

Larry E. Laubscher, Jr. of Laubscher & Laubscher for Decker Manufacturing Corporation.

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Before Hohein, Chapman and Holtzman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Preliminarily, a recitation of the recent procedural history of this appeal is in order. On May 16, 2001 the Board issued a final decision on this appeal affirming the Examining Attorney. Applicant timely filed a request that the appeal be reopened because applicant's attorney did not receive a copy of the Examining Attorney's February 23, 2001 appeal brief. On June 28, 2001 the Board vacated its May 16, 2001 final decision, reopened this appeal, and allowed applicant time to file a reply brief and/or a request for an oral hearing. Applicant timely filed a

reply brief on July 12, 2001 (via a certificate of mailing). Applicant's attorney's law office was subsequently telephoned by Board personnel to confirm whether or not applicant had filed a request for an oral hearing and was advised that applicant did not file a request for an oral hearing. Thus, this appeal is now fully briefed and ready for a final decision.

Decker Manufacturing Corporation seeks to register on the Principal Register the mark D__ for goods identified, as amended, as "metal fasteners, namely nuts and pipe plugs" in International Class 6. The application was filed June 10, 1998, based on Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a), with applicant claiming dates of first use and first use in commerce of August 1959. The application also included the following statements: "The mark comprises the letter D and a single digit numeral denoting a class. The numeral is disclaimed apart from the mark as shown." The method of use clause states that the mark is used by "applying it to the goods." A specimen of record is shown below (in reduced form)¹:

¹ We note that applicant's drawing shows the mark as a letter "D" in a horizontal line and immediately next to the blank space ("__"), whereas applicant's specimens show the letter "D" at the top of the nut and the numeral (on the specimen it is a "9") on

The Examining Attorney has refused registration on two grounds: (1) that under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), applicant's mark, when applied to its identified goods, so resembles the previously registered mark D for "metal studs and nuts,"² in International Class 6, as to be likely to cause confusion, mistake or deception; and (2) that the applied-for mark is a "phantom" mark which violates the one mark per registration requirement of Sections 1 and 45, 15 U.S.C. §§1051 and 1127, of the Trademark Act.

the bottom of the nut in vertical alignment, with the hole in the nut spatially separating the letter and the numeral.

² Registration No. 1,756,432, issued March 9, 1993, Section 8 affidavit accepted, Section 15 affidavit acknowledged. The claimed date of first use and first use in commerce is June 1, 1961.

When the refusals were made final, applicant appealed. As explained above, the appeal is now fully briefed, and applicant did not request an oral hearing.

"Phantom" Mark Refusal

The Examining Attorney contends that the line in applicant's mark represents a changing or "phantom" element, specifically any of the single digit numbers (0-9), and that under the Trademark Act an applicant may properly seek to register only a single mark in an application for registration.

Applicant contends that "there are no phantom elements in the subject mark." (Brief, unnumbered page 2). However, applicant goes on to argue that because of the statements included in the application describing the mark, there are a very limited number of elements which can be included in the mark, each numeral designating a type or class of metal fasteners; and that all of the possible single digit numerals placed with the letter D represent minimal variances and "all represent a consistent commercial impression." (Brief, unnumbered page 2).

In its reply brief (submitted by applicant, as noted previously, after receipt of the Board's initial final decision in this case), applicant contends that because its

application includes a statement that a portion of the mark denotes a single digit number which has been disclaimed, "members of the public are well advised as to the nature of applicant's mark." (Reply brief, p. 2.) Applicant attempts to distinguish its situation from that in the case of *In re International Flavors & Fragrances Inc.*, 183 F.3d 1361, 51 USPQ2d 1513 (Fed. Cir. 1999), arguing that the *International Flavors* case involved a mark where the "phantom" portion thereof could include an "unknown" number of marks, whereas applicant seeks a mark with a limited number of possible single digit numerals; and that, unlike the situation in the *International Flavors* case, it is possible to conduct a search of all permutations of applicant's mark, and in fact, "such a search would be comparable to a search regarding a stylized mark." (Reply brief, p. 2.)

The Court of Appeals for the Federal Circuit addressed the issue of "phantom" marks in *In re International Flavors & Fragrances Inc.*, supra, wherein the court stated as follows (emphasis appears in the Court decision):

We agree with the Commissioner that under the Lanham Act and the rules promulgated thereunder, a trademark application may seek to register only a *single* mark. See, e.g., 15 U.S.C. §1051 (1994) ("The owner of a *trademark*...may apply to register his or her *trademark*

under this chapter on the principal register established:...")
...The language of the relevant regulations also contemplate that an application may seek to register only a single mark. See, e.g., 37 C.F.R. §2.51(a)(1) (1998) ("In an application under section 1(a) of the [Lanham] Act, the drawing of *the trademark* shall be a substantially exact representation of *the mark* as used on or in connection with the goods...).

The Court noted that the Trademark Act gives federal procedural augmentation to the common law rights of trademark owners; and the law serves as constructive notice to the public of the registrant's ownership of a mark, thereby preventing another user of that mark from claiming innocent misappropriation. Thus, "the mark, as registered, must accurately reflect the way it is used in commerce so that someone who searches the registry for the mark, or a similar mark, will locate the registered mark." International Flavors, supra at 1517. "Phantom" marks do not provide proper notice to other trademark users, thereby defeating one of the vital purposes of the Trademark Act.

We agree with applicant that the "line" portion of its mark represents a single digit numeral, and that there are a finite number of single digit numerals, specifically, ten. However, as the Court emphasized, the Trademark Act provides for the application for registration of "a

trademark." Even though the "mark" in applicant's application may represent a finite number of possible marks, it clearly includes multiple marks. Moreover, any search would necessarily require a search of at least ten marks, one of which would be for "D0," which could be interpreted as the word "DO." This is not comparable to a search of "a stylized mark"; it is comparable to searching at least ten stylized marks. Moreover, these multiple marks create different commercial impressions.

The variable element in the International Flavors case, supra, was also descriptive, but the Court nonetheless found such applications are prohibited under the statute. The "line" portion of applicant's mark represents a numeral which is a class designation. The class designations are descriptive and applicant has disclaimed same.

Applicant's application for D__ is an attempt to register several different marks in one application, which is not permitted under the Trademark Act. Neither the fact that there are only ten single digit numerals nor the fact that each of the single digit numerals denotes a class of metal fasteners alters the reality that in this application applicant seeks to register several marks in one application in contravention of the Trademark Act.

Section 2(d) Refusal

The Section 2(d) issue we must determine is whether applicant's mark is so similar to the cited registered mark that, when used in connection with the same or similar goods, it will be likely to cause confusion as to the source or origin of the goods. See *Kangol Ltd. v. KangaROOS U.S.A. Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992). Our determination of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

We turn first to a consideration of applicant's goods vis-a-vis those of the cited registrant. We find that the goods are in part identical ("metal nuts"), and are otherwise closely related ("metal fasteners, namely pipe plugs" and "metal studs"). Applicant does not argue to the contrary.

Likewise applicant does not argue, and we do not find, any differences in the channels of trade or purchasers for the respective goods. We must presume, given the identifications, that such goods travel in the same channels of trade, and are purchased by the same classes of purchasers. See *Canadian Imperial Bank of Commerce v.*

Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

Turning then to a consideration of the respective marks, it is well settled that marks must be considered in their entirety. However, our primary reviewing court has held that in articulating reasons for reaching a conclusion on the question of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature or portion of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entirety. That is, one feature of a mark may have more significance than another. See *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987); and *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985).

Applicant concedes that the single digit numeral (represented by the "line" element of its mark) denotes a class of fasteners, and applicant voluntarily offered a disclaimer of same. See *In re Dana Corp.*, 12 USPQ2d 1748 (TTAB 1989).³ Thus, the letter "D" is the dominant portion

³ In our May 16, 2001 decision, the Board cited *In re Dana Corp.*, 12 USPQ2d 1748 (TTAB 1989) for the principle that terms used merely as model, style or grade designations do not serve to identify and distinguish one party's goods from those of another; and that this relates to the dominance of the letter "D" in

of applicant's mark, and would be so perceived by purchasers, especially in view of applicant's actual use of the letter "D" at the top of the nut and the numeral spatially separated therefrom, appearing at the bottom of the nut. In such circumstance, the marks are virtually identical. See *Textron Inc. v. Maquinas Agricolas "Jatco" S.A.*, 215 USPQ 162 (TTAB 1982).

Moreover, consumers generally do not have the opportunity to make side-by-side comparisons. The proper test in determining likelihood of confusion is not a side-

applicant's mark when analyzing the du Pont factor of similarities between the marks. In attempting to distinguish the Dana Corp. case, supra, applicant states in its reply brief (p. 4) as follows:

"In Dana, the applicant sought to register alphanumeric designations which were not inherently distinctive and which had not acquired secondary meaning. In the instant application, the mark which Applicant seeks to register has been in use by Applicant since 1959. Given this long and continuous use, Applicant asserts that the mark has acquired secondary meaning."

There is no evidence to support applicant's claim of acquired distinctiveness. Moreover, in this case, it is unclear as to what exactly applicant asserts has acquired distinctiveness (e.g., the mark "D__" has not been used and has not acquired distinctiveness). Nor has applicant specified which of the marks D0, D1, D2, D3, etc. have been used to such an extent that each separate mark has acquired distinctiveness. Finally, applicant has acknowledged the numeral designations are descriptive and that they are class designations of applicant's goods; thus, the principle of the Dana Corp. case, supra, applies herein. In any event, a claim of acquired distinctiveness cannot overcome the Section 2(d) refusal.

by-side comparison of the marks, but rather is based on the similarity of the general overall commercial impressions engendered by the involved marks. See Puma-Sportschuhfabriken Rudolf Dassler KG v. Roller Derby Skate Corporation, 206 USPQ 255 (TTAB 1980). See also, Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); and Spoons Restaurants Inc. v. Morrison Inc., 23 USPQ2d 1735 (TTAB 1991), aff'd unpub'd (Fed. Cir., June 5, 1992).

While the mark applied for by applicant is D__, the mark as actually used by applicant, as evidenced by applicant's specimens, clearly shows that the letter and the numeral are spatially separated. Thus, we disagree with applicant's argument that "the mark *as represented in the application* is the mark which will be used by consumers as a source identifier, namely D and a single digit number." (Reply brief, p. 3.) (Emphasis added.) The purchasing public forms its impressions of trademarks as they are actually used in the marketplace, not as they appear in federal trademark applications/registrations.

Based on applicant's specimens of record, showing the letter "D" spatially distant from the single digit numeral (whichever one of ten such numbers), the purchasing public will not perceive applicant's mark as D__, but rather would

see only the letter "D" at the top, with the number designation denoting the class of metal fastener being purchased. Applicant's mark, as shown on its specimens, would be remembered by purchasers as the letter "D," which is identical to the cited registered mark.⁴

Applicant's argument that there has been contemporaneous use for over 39 years without evidence of actual confusion is not persuasive. There is no evidence of the circumstances of use by any party (e.g., nationwide use or use in separate or limited areas; substantial sales and/or advertising or very limited sales and/or advertising). Nor is there any information from the cited registrant regarding its experience as to actual confusion or lack thereof. Applicant did not offer a written consent from the cited registrant. See *In re Kent-Gamebore Corp.*, __ USPQ2d __ (TTAB, May 10, 2001). Applicant's argument

⁴ We are, of course, aware that the Examining Attorney originally cited two registrations: Registration No. 1,756,432, which is the basis for the final refusal in this appeal, and Registration No. 1,263,383, which was not maintained as a basis for refusal in the Examining Attorney's final Office action. Applicant's argument that its mark "D__" is distinguishable from the cited registration for "D", as well as from the other once-cited registration for the mark shown below

for, inter alia, "bolts, nuts, screws," is not persuasive of a different result herein. While the Patent and Trademark Office strives for consistency, each case must be decided on its own facts and record. Of course, we do not have before us any information from the file for Registration No. 1,263,383.

that because of the long period of contemporaneous use without evidence of actual confusion, "such an agreement is not necessary" (reply brief, p. 4), is not persuasive where there is simply no evidence regarding the relative scope and nature of the respective uses of the marks by applicant and registrant.

Finally, applicant argues regarding the du Pont factor of market interface between applicant and registrant that they "have long been members of the same commercial market," but that applicant is not aware of any objections from registrant regarding applicant's mark; and that "[i]f the mark is published, Registrant will have the opportunity to oppose the same." (Reply brief, p. 4.)

The applicant in the case of *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997) made this same argument, and the Court responded as follows (at 1535):

Dixie argues alternatively that the PTO should pass the mark to publication and allow the registrant to oppose the applicant's mark, if it chooses. But it is the duty of the PTO and this court to determine whether there is a likelihood of confusion between two marks. (Citation omitted.) It is also our duty 'to afford rights to registrants without constantly subjecting them to the financial and other burdens of opposition proceedings.' (Citations omitted.)

Otherwise protecting their rights under the Lanham Act would be an onerous burden for registrants.

Because we find that confusion is likely to occur in this case, it is not appropriate to allow applicant's mark to be published.

Based on the similarity of the marks, the identical and/or related goods, identical trade channels and same classes of purchasers, we find that applicant's use of its mark on its goods would be likely to cause confusion, mistake or deception in view of the cited registrant's mark.

Decision: The refusal to register under Section 2(d), and the refusal to register a "phantom" mark, are both affirmed.